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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,025	02/25/2004	Sampo Sovio	4208-4169	9035

27123 7590 07/24/2006

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NEW YORK, NY 10281-2101

EXAMINER

AUGUSTIN, EVENS J

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/785,025	SOVIO ET AL.	
	Examiner	Art Unit	
	Evans Augustin	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

An interview was held on 4/18/2006, in which the claims were explained in further details vis-à-vis the prior art. The USPTO has obtained a more comprehensive understanding of the claimed invention. As a result, it has become clear that there are two distinct inventions within the application, and election/restriction requirements are in order.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-26 and 33-49 are drawn to a method/system of using fob/token/wallet in conjunction with cell phone to complete transaction, classified in class 705, subclass 64-67.
 - II. Claims 27-32 are drawn to a transponder/transceiver for wireless communication with other devices, classified in class 340, subclass 10.1.

According to 35 U.S.C. 121, if two or more “independent and/or distinct” inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more “independent and distinct inventions” may not be claimed in one application. Inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and non-obvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c)

2. Inventions in groups I and II are directed to method/system and apparatus. The inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j).

3. In the instant case, the inventions are distinct, each from the other because of the following reasons: Group I is related to a method/system of using fob/token/wallet in conjunction with cell phone to complete transaction, where as group II is related to a a transponder/transceiver for wireless communication with other devices. The inventions in the two groups are patentable over each other. The invention in group II does not necessarily require the method/system in group I, in order to operate. Looking at the structure of the apparatus in group II, the transponder can be used for other application such as toll booth access (Ezpass) or to quickly complete a transaction at an Exxon Mobil gas station (Speedpass) or to complete a transaction at fast-food chains such as McDonalds. Therefore, the inventions in groups I and II are not mutually exclusive.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Additionally, the inventions as claimed, would put serious burden on the examiner because the inventions are in separate field search, and would require additional queries and claim analysis in order to accomplish a meaningful search result.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Evens Augustin whose telephone number is (571) 272-6860. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Calvin Loyd Hewitt II, can be reached at (571) 272-6709.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry
and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

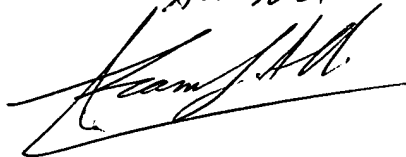
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PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Evens Augustin
Patent Examiner
July 17, 2006.

KAMBIZ ABDI
PRIMARY EXAMINER

AA 3621

A handwritten signature in black ink, appearing to read 'Kambiz Abdi', written over a horizontal line.